

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: LUBERT STRYER and SERGEY ZOZULYA



Application No. 09/886,055

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on October 5, 2006. A review of the application has revealed that the application is not ready for review and consideration. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

An Appeal Brief was filed on May 15, 2006 under the rules set forth in 37 CFR § 41.37(c). However, a review of the Appeal Brief reveals that it is not in compliance with the new rules under 37 CFR § 41.37(c), which state:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section.

A review of the appellant's Appeal Brief reveals that the following required appendices are missing:

37 CFR § 41.37(c)(1)(ix), which states:

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

and 37 CFR § 41.37(c)(1)(x), which states:

(x) ***Related proceedings appendix.*** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

Section 37 CFR § 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

It is required that a substitute Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c).

EXAMINER'S ANSWER

On July 6, 2006, an Examiner's Answer was mailed in response to the Appeal Brief received May 15, 2006. A review of the Examiner's Answer reveals that it is not in compliance

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with the Manual of Patent Examining Procedure (MPEP). In the "Evidence Relied Upon" (section 8), the examiner indicates no evidence of record was relied upon. In accordance with MPEP § 1207.02, the "Evidence Relied Upon" (section 8) should include:

(8) Evidence Relied Upon

A listing of evidence relied on (e.g., patents, publications, admitted prior art), and in the case of non-patent references, the relevant page or pages.

Correction of the record is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the examiner:

- 1) to hold the Appeal Brief filed May 15, 2006, 2006 defective;
- 2) to notify appellants to file a Substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 3) to vacate the Examiner's Answer mailed July 6, 2006 and issue a revised Examiner's Answer to include all information required under 37 CFR § 41.37; and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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